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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,214	01/21/2004	Kia Silverbrook	WAL15US	1372
24011 7590 05/31/2007 SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			EXAMINER GOLDBERG, BRIAN J	
			ART UNIT 2861	PAPER NUMBER
			MAIL DATE 05/31/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/760,214

Applicant(s)

SILVERBROOK ET AL.

Examiner

Brian Goldberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-4,9,21-30 and 45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,9,21-30 and 45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☒ Certified copies of the priority documents have been received in Application No. 09/112,767.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 3/19/07.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Priority*

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) as follows:

This application is claiming the benefit of prior-filed nonprovisional application No. 10/160273 under 35 U.S.C. 120, 121, or 365(c), which is claiming the benefit of prior-filed nonprovisional application No. 09/112767. Copendency between application No. 10/160273 and the prior application No. 09/112767 is required. Since the applications are not copending, the benefit claim to the prior-filed nonprovisional application is improper. Applicant is required to delete the reference to the prior-filed application from the first sentence(s) of the specification, or the application data sheet, depending on where the reference was originally submitted, unless applicant can establish copendency between the applications. The issue fee for application No. 09/112767 was dated 2/4/02 and the filing date of application No. 10/160273 was 6/4/02. Therefore, these applications were not copending.

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the

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requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 10/160273, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. The prior-filed application does not appear to provide adequate support for the printhead being supplied with a number of different inks which are remote from the printhead and which supply the printhead through tubes as claimed in claim 1 of the instant application; and most certainly does not provide proper support for any of claims 2-4, 9, 21-30, and 45.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

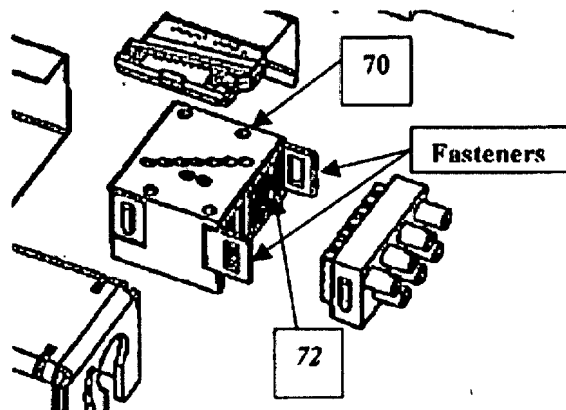
2. Claims 1-4, 9, 21-23, 24-27, and 28-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Silverbrook (US 20020180834).

3. Regarding claim 1, Silverbrook discloses “a full width printhead located across the path (see abstract and Par [0093]); the printhead comprising a color printhead which is at least as wide as the web (see abstract and Par [0059]); the printhead being supplied with a number of different inks which are remote from the printhead and which supply the printhead through tubes (Par [0057] and [0059]).”

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4. Regarding claim 2, Silverbrook discloses “a rail which is located across the path and along which the printhead slides into and out of a printing position (Par [0057], [0013], [0014]).”

5. Regarding claim 3, Silverbrook discloses “the printhead is secured to the rail by fasteners which allow the printhead to be removed when the fasteners are disengaged (Par [0057] and see Fig 8 below).”



6. Regarding claim 4, Silverbrook discloses “the inks are contained in individual reservoirs and a supply tube connects each reservoir to the printhead (Par [0057] and [0059]).”

7. Regarding claim 9, Silverbrook discloses “a coupling in each ink supply tube which can be disconnected so that the printhead can be withdrawn (Par [0059]).”

8. Regarding claims 21-23, the printing rate does not substantially further limit the structure of the printhead assembly and the rates could be reached through routine experimentation for optimization since such experimentation would result in acquiring the best possible quality. Also, even if it does further limit the structure, the various

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printing rates are disclosed by Silverbrook (see chart at the bottom of page 9 where the printing rate exceeds 7750 square feet per hour).

9. Regarding claims 24-27, Silverbrook discloses the various number of nozzles claimed (see Par [0093] where 552960 nozzles are disclosed).

10. Regarding claims 28-30, Silverbrook discloses the various volumes for the ink drops (see Par [0095] where 1 picoliter is disclosed).

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Silverbrook in view of Martin (20020171692). Silverbrook discloses the claimed invention as set forth above regarding claim 1. Silverbrook also discloses "the printhead being supplied by separate ink reservoirs, the reservoirs connected to the printhead by an ink supply harness, there being a disconnect coupling between the reservoirs and the printhead (Par [0057] and [0059])." Thus Silverbrook meets the claimed invention except "a housing in which is located a media path which extends from a blank media intake to a wallpaper exit slot; a multi-color roll width removable printhead located in the housing and across the media path; one or more input devices for capturing operator instructions; a processor which accepts operator inputs which are used to configure the printer for producing a particular roll."

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13. Martin teaches “a housing in which is located a media path which extends from a blank media intake to a wallpaper exit slot (see Fig 2 with media 27, enters from supply 24, exits to take-up 26); a multi-color roll width removable printhead located in the housing and across the media path (20 of Fig 2, see Par [0009]); one or more input devices for capturing operator instructions (36, 37 of Fig 2); a processor which accepts operator inputs which are used to configure the printer for producing a particular roll (38 of Fig 2, Par [0009] and [0010]).” It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the housing, input devices, and processor disclosed by Martin with the printhead assembly disclosed by Silverbrook. One would have been motivated to so modify Silverbrook for the benefit of allowing the user to personalize the media by arranging the printed images in a pattern, as stated by Martin.

### ***Response to Arguments***

14. Applicant's arguments filed 3/19/07 have been fully considered but they are not persuasive. Applicant's petition for delayed priority claim under 35 U.S.C. 120 is acknowledged. However, as set forth above, the parent and grandparent applications cited were never copending and thus cannot claim priority benefit. Also, the cited parent application of this application does not appear to provide support for claim 1 of the instant application and certainly does not provide support for claims 2-4, 9, 21-30, and 45. Even if applicant can cite support for claim 1 that the examiner has overlooked, the cited references would still be valid under 35 U.S.C. 102(e).

***Conclusion***

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Goldberg whose telephone number is 571-272-2728. The examiner can normally be reached on Monday through Friday, 9AM-5PM. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Luu can be reached on 571-272-7663. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian Goldberg *BG*  
AU 2861  
May 25, 2007



**MATTHEW LUU**  
**SUPERVISORY PATENT EXAMINER**